

REMARKS

Claims 1-13, 16-20, 25-31, 33, 34, 56, 57, 67, 68, 92, 93, 95, and 115-121 were presented and were rejected. The applicants appreciate acknowledgement that claim 14 is allowable and that claims 123-124 would be allowable if written in independent form and all issues with claim 122 are resolved. Accordingly, claim 14 has been rewritten as an independent claim that incorporates all limitations of claims 1 and 11. It is therefore believed to be allowable. Claims 33, 34, 56, 67, 118 and 119 now incorporate all limitations of claim 14, and are also believed to be allowable. Claims 1-12, 15-32, 35-55, 57-66, and 68-117 and 121 have been canceled.

Claim 120 has been amended to represent part of claim 13 (i.e., claim 1 plus the added limitations of claim 13), the aspect of that claim which requires the microdevice to comprise a metal layer having a magnetic material. The alternative limitation of claim 13, focused on limiting the binding partner, has been removed to simplify examination. New claims 126-132 depend from claim 120 and correspond to canceled claims 5-7 and 11-14. These amendments simplify issues for examination and place the application in better condition for appeal. No new matter is added by the amendments. Entry of the amendment is respectfully requested.

Claims 122-125 were added in the previous amendment; the Examiner asked for clarification of the support for these claims. The applicant pointed out support for the new claims is found throughout the specification, for example at page 77, last paragraph, through page 78. This section describes a method for making a microdevice of the invention, and the discussion describes the device according to these claims, having a first layer as a substrate, on which a layer of metal that can be a magnetic material is applied and is then patterned to provide encoding features. An optional top layer may be applied, too, as discussed therein. Nickel and CoTaZr are specific examples of the metal used for this layer. Figures 4 and 13 also provide additional description of representative microdevices having patterned magnetic material thereon. Thus the specification clearly demonstrates that the applicant had possession of the subject matter of claims 122-125 when the application was filed. As is well established, that is what is required to support these claims:

there is no requirement for the specification to provide verbatim support. Accordingly, these claims are supported by the application as filed and do not introduce new matter.

The grounds for rejection have been carefully considered. Reconsideration of the rejection in view of the following remarks is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 1-13, 16-20, 25-31, 34, 67, 68, 92, 93, 95, and 115-121 were rejected as allegedly obvious based on Kaye (GB 2306484) in view of Wu, et al. (US 6,221,677).

With respect to claims 13 and 28-31, the Office Action says that Wu allegedly discloses ‘electromagnetic materials for facilitation of the binding by physical force, such as magnetic interaction.’ The Examiner cited page 15, lines 15-17 of Wu for this proposition. There is no such disclosure in that section of Wu: the Applicant believes the Examiner intended to refer to a passage in Kaye that was previously cited against these claims. That passage in Kaye, however, has been badly misconstrued: it refers only to use of electromagnetic radiation to *modify* materials that can be included in the particle of Kaye. **It does *not* refer to any force that can be used to manipulate a microdevice; in fact, it does not refer to any use of a magnetic force or a magnetic material at all.** It relates to use of radiation, not magnetism. This passage is entirely irrelevant to the added limitations of claims 13.

The first step in a *Graham* analysis for obviousness is determining the scope and content of the prior art. This rejection is based on a clear misinterpretation of the cited language in Kaye, which the Applicant has pointed out before. The *Graham* analysis is clearly defective, because it relies upon an express interpretation of the scope and content of the prior art that is plainly wrong. Accordingly, the stated rejection of claim 13 is improper and should be withdrawn.

Claim 120 has been rewritten as an independent claim and amended to capture one aspect of the subject matter of claim 1 rather than both alternatives. Claim 120 does not describe the ‘binding partner’ alternative of claim 1 (now in claim 13). As has been pointed out before, the Examiner’s

theory of obviousness requires the device of Kaye to be used to bind to and manipulate moieties: that use is not contemplated by Kaye, which provides a substrate on which to synthesize molecules. Kaye does not disclose or suggest use of its device to bind to moieties and manipulate those moieties. The combination with Wu requires Kaye to be used in a way that changes its entire principle of operation. Kaye was not designed for such uses. MPEP 2143.01(IV): “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F2d 810, 123 USPQ 349 (CCPA 1959).”

Claims 122-125 require a patterned magnetic material and further limit that patterned magnetic material. None of the references disclose or suggest a layer comprising a patterned magnetic material, or any of the further limitations of claims 123-125. Accordingly, these claims are believed to be allowable.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 471842000500. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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